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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,916	07/07/2003	Marco Vicić	05725.1222-00	6931

22852 7590 05/16/2007  
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WASHINGTON, DC 20001-4413

EXAMINER

GEORGE, KONATA M

ART UNIT	PAPER NUMBER
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1616

MAIL DATE	DELIVERY-MODE
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05/16/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/612,916

**Applicant(s)**

VICIC ET AL.

**Examiner**

Konata M. George

**Art Unit**

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1-47 are pending in this application.

#### ***Action Summary***

1. The provisional rejection of claims 1-47 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 and 26-53 of copending application 10/612,920 is hereby withdrawn as applicant has filed a terminal disclaimer.
2. The rejection of claims 1-47 under 35 U.S.C. 102(e) as being anticipated by de la Poterie is being maintained for the reasons stated in the office action dated August 25, 2006.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-47 are rejected under 35 U.S.C. 102(e) as being anticipated by de la Poterie (US 6,113,925).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

de la Poterie discloses a method of forming a film, which may be used as a nail varnish comprising a film former in an aqueous medium (abstract). Column 4, lines 25-40 disclose the film-forming materials such as polyurethane, acrylic, vinylic or styrene-acrylic polymers and that the film-formers can be present in an amount ranging from 2% to 60%. Additional additives, adjuvants, excipients, etc. can be added to the composition such as organic solvents i.e. ketenes (col. 3, lines 25-26), pigments (col. 4, lines 60-62) and UV screening agents, preservatives or wetting agents (col. 5, lines 6-16). The examples teach using SANCURE® as a film-former, since SANCURE® is a known polyurethane then it would have all the properties as claimed by applicant. The functional language as claimed by applicant would be inherent to the composition of de la Poterie as the prior art teaches the same composition.

#### ***Response to Arguments***

4. Applicant's arguments filed February 23, 2007 have been fully considered but they are not persuasive.

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The applicant argues that de la Poterie does not teach the claimed invention. The examiner disagrees. The instant invention is directed towards a composition comprising a cosmetically acceptable medium and at least one film-forming polymer. The amendment to claim 1, requiring that the polymer "is soluble in an organic solvent..." merely further describes characteristics of the polymer. Paragraphs [0036-0040] and the exemplified example of the applicant's specification describes examples of the claimed film-forming polymer i.e. polyurethanes, polyureas, etc. Column 4, lines 25-40 of de la Poterie teaches examples of film-forming materials that can be employed in the composition of which polyurethanes are mentioned. Since polyurethane is mentioned in the prior art as the film-forming polymer and is taught by applicant as an example in the instant invention, it is anticipated that it would have the same characteristics as claimed. The applicant does not teach in the specification examples of a cosmetically acceptable medium, therefore, any of the cosmetically acceptable mediums known in the cosmetic art can be employed with a reasonable expectation of success. Since the composition of the instant invention and of de la Poterie are the same, all of the limitations would be inherent.

***Conclusion***

5. Claims 1-47 remain rejected.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

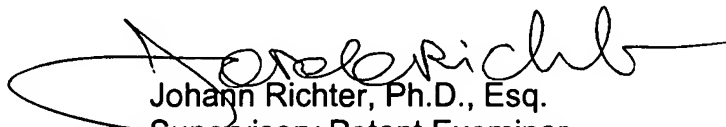
***Telephone Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Konata M. George, whose telephone number is 571-272-0613. The examiner can normally be reached from 8AM to 6:30PM Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter, can be reached at 571-272-0646. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have question on access to the Private Pair system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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